

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 076333/0108

RECEIVED

In re patent application of

Joel S. Greenberger.

Filed: August 6, 1997

Serial No.: 08/907,041

Title: PROTECTION FROM IONIZING IRRADIATION OR CHEMOTHERAPEUTIC
DRUG DAMAGE BY *IN VIVO* GENE THERAPY



Group Art Unit: 1633

Examiner: S. Chen

ECH CENTER 1600/2300

REQUEST TO RESCIND ERRONEOUS ABANDONMENT OF APPLICATION

Commissioner for Patents
Washington, D.C. 20231

Sir:

Receipt is acknowledged of the Notice of Abandonment dated September 12, 2000, in the subject application. The abandonment is believed to be erroneous, and applicants hereby request that the abandonment of the above-identified application be rescinded for the following reasons.

1. The subject case is a file wrapper continuation of an earlier application (USSN 08/484,830). The file wrapper continuation was filed on August 6, 1997, following a final rejection in the parent case dated May 6, 1997.
2. On March 17, 1999, applicant received an Official Action in the subject case. The action raised substantive issues that had not been raised in the final rejection in the parent case, and was therefore not made final.
3. On September 17, 1999, applicant filed a response to the March 17th Official Action, along with a request for a 3-month extension of time and the required fee. Applicant's September 17th filing responded to every issue raised in the March 17th Action. In particular, applicant restated their position that the examiner had not supported his position that the claims were not enabled under the first paragraph of 35 U.S.C. §112 as required by *In re Marzocchi*, 169 USPQ 367 (CCPA 1971). The response was accompanied, however, by a petition to suspend action under 37 C.F.R. §1.103. It was applicant's hope that additional *in vivo* data might be available in order to advance prosecution.

4. On December 6, 1999, applicant received a favorable decision on their petition.

5. The undersigned responded to a telephone call to Stephen Bent by Examiner Chen, and left a voice mail indicating that additional data would not be provided at this time, and requesting a return call to discuss.

6. On September 12, 2000, applicant received a Notice of Abandonment, for "failure to timely file a proper response to the Office letter mailed on December 6, 2000."

The Patent Office has never responded to applicant's comments on the new substantive issues raised in the March 17th Action. Accordingly, it is submitted that the examiner was obliged to provide a further Action in this case. It is requested that the Patent Office rescind the Notice of Abandonment dated September 12, 2000.

No fee is believed to be payable in this case, however, the Commissioner is hereby authorized to charge any required fee to Deposit Account No. 19-0741.

Respectfully submitted,

Date

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